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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/624,593

07/23/2003

Kei Hayasaki

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06/01/2007

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

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EXAMINER

DUDA, KATHLEEN

ART UNIT

PAPER NUMBER

1756

MAIL DATE

DELIVERY MODE

06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/624,593	Applicant(s) HAYASAKI ET AL.	
	Examiner Kathleen Duda	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20,23-25,27,28,30-32,37,39,45,47 and 49-133 is/are pending in the application.
- 4a) Of the above claim(s) 49-131 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-20,132 and 133 is/are allowed.
- 6) ☒ Claim(s) 23-25,27,28,30-32,37,39,45 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10232006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 3-20, 23-25, 27, 28, 30-32, 37, 39, 45, 47 and 49-133 are pending in this application.

Information Disclosure Statement

2. Applicant's arguments have been persuasive in reconsideration of the WO 99/49504 reference. Enclosed is a signed PTO-1449 indicating the consideration of the English language abstract for that reference.

Election/Restrictions

3. This application contains claims 49-131 drawn to an invention nonelected with traverse in the reply filed on July 13, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 23-25, 27, 28, 30-32, 37, 39, 45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims under rejection recite reforming/slimming after application of a film, exposure of the film but before development to form the pattern. Applicant argues that support for this recitation is found in the specification at page 54, lines 12-14 and Figure 28, for example. Figure 28 starts with the first step (step s401) being the pattern-forming step. The examiner has considered all of the citations provided but has not found support for the recitation of the claims.

The claims as written do not support taking a pattern and repeating the process as argues by applicant. The claims would need to be amended to support that argument. The claims recite a film, not pattern, which is exposed, slimmed/reformed and then developed to form a pattern. The examiner agrees that slimming/reforming of a pattern is supported by the originally filed specification but not slimming/reforming of an exposed film which has not yet been developed as recited in the claims under rejection.

The recitation of "reforming" as support in the originally filed specification has argued by Applicant. Support is provided on at least page 41, lines 6-10 where reforming is taught to be by "oxidizing liquid".

Response to Amendment

6. The art rejections of claims 23-25, 27, 28, 30-32, 37, 39, 45 and 47 have been removed because the claims recite a process whereby the film is treated with the specified process after exposure but before development which is not taught by the prior art. These claims are rejected under 35 USC 112, 1st paragraph as discussed above.

Allowable Subject Matter

7. Claims 3-20, 132 and 133 are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-

MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Examiner K. Duda at (571) 272-1383. Official FAX communications should be sent to (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff, can be reached at 571-272-1385.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen Duda
Primary Examiner
Art Unit 1756